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09/995,970	11/28/2001	Miruka Ishii	09812.0180-00000	9242

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EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/995,970

Applicant(s)

ISHII, MIRUKA

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-23, 25-28, 41 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-20, 25-28, 41 and 44-53 is/are rejected.
- 7) ☒ Claim(s) 8-10 and 21-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07-11-2006 has been entered.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-7, 12-20, 25-28, 41 and 43-53 have been considered but are moot in view of the new ground(s) of rejection.

Reviewing the Applicant's remarks, the Applicant briefly argued that the cited references failed to teach the features of third communication device (recipient's terminal):

Being a *wireless* communication device; and

Being capability to *store* said audio content data.

Therefore, this Office Action is focused on such above argued features.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 12-13, 15-18, 25-26, 28, 46-48 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen (US Pat. #: 5,870,454 as cited in the previous Office Action) in view of Helferich et al. (US. Pat. #: Re. 34,976).

Regarding claim 1, Dahlen teaches a communication system comprising:

a first communication device (i.e., calling party's device 22 as shown in figure 1) for transmitting outgoing data including content identification data (i.e., identifier or code of a prestored message; col.6, lines 5-23), transmitting party identification data (i.e., PIN or password, col.5, lines 41-44), receiving party identification data (i.e., destination identifier of the called party, col.5, lines 45-52), and date and time data (col.6, lines 41-50); and

a second communication device (i.e., SCP 40 and SDP 50) for receiving said outgoing data and for transmitting content data identified by said content identification data to a receiving party identified by said receiving party identification data at a date and time corresponding to said date and time data (col.7, lines 1-44).

It should be noticed that Dahlen further teaches a third *wireless* communication device (i.e., receiving equipment of the called party such as GSM mobile radio 100E as shown in figure 1) for receiving and reproducing said content data transmitted from said second communication device (col.8, lines 3-35) and the text-to-speech conversion service (see col.10, line 60 through col.11, line 29). Dahlen, however, fails to clearly teach the features of storing the audio content data from the second communication device without pushing an off-hook button. However, Helferich et al. ("Helferich") teaches an analog/digital voice storage cellular telephone that *records or stores* voice content data such as voice messages while the user is away from the

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cellular telephone unit (*without pushing an off-hook button*) (see the Abstract) for immediately delivering messages to recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of storing the audio content data from the second communication device without pushing an off-hook button, as taught by Helferich, into view of Dahlen in order to directly provide the messages to the recipient.

Regarding claim 2, Dahlen further teaches limitations of the claim in col.6, line 61 through col.7, line 34.

Regarding claim 3, Dahlen further teaches limitations of the claim in col.5, line 36 through col.6, line 60; col.7, lines 49-54; col.8, lines 30-35; and col.10, lines 33-48.

Regarding claim 4, Dahlen further teaches limitations of the claim in col.6, lines 17-21.

Regarding claim 5, Dahlen further teaches limitations of the claim in col.7, line 45 through col.8, line 14; and col.10, lines 19-48.

Regarding claims 12-13 and 15, Dahlen further teaches limitations of the claim in col.10, lines 38-48.

Regarding claim 16, Dahlen teaches a communication device (i.e., Prompt & Collect Information 70) comprising:

receiving means for receiving outgoing data including content data identification data, transmitting party identification data, receiving party identification data, and date and time data from a first communication device (col.7, lines 1-44);

storing means for transmitting said outgoing data;

transmitting means for transmitting content data identified by the stored content identification data (i.e., identifier or code of a prestored message; col.6, lines 5-23), transmitting party identification data (i.e., PIN or password, col.5, lines 41-44) to a second device; and

controlling means for exercising control to transmit said content data identified by said content identification data to a receiving party identified by said receiving party identification data in the stored outgoing data at a date and time corresponding to said date and time data (col.5, lines 45-52 and col.6, lines 41-50).

It should be noticed that Dahlen further teaches a third *wireless* communication device (i.e., receiving equipment of the called party such as GSM mobile radio 100E as shown in figure 1) for receiving and reproducing said content data transmitted from said second communication device (col.8, lines 3-35) and the text-to-speech conversion service (see col.10, line 60 through col.11, line 29). Dahlen, however, fails to clearly teach the features of storing the audio content data from the second communication device without pushing an off-hook button. However, Helferich teaches an analog/digital voice storage cellular telephone that records or stores voice content data such as voice messages while the user is away from the cellular telephone unit (*without pushing an off-hook button*) (see the Abstract) for immediately delivering messages to recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of storing the audio content data from the second communication device without pushing an off-hook button, as taught by Helferich, into view of Dahlen in order to directly provide the messages to the recipient.

Regarding claim 17, Dahlen further teaches limitations of the claim in col.5, line 36 through col.6, line 60; col.7, lines 49-54; col.8, lines 30-35; and col.10, lines 33-48.

Regarding claim 18, Dahlen further teaches limitations of the claim in col.7, line 45 through col.8, line 14; and col.10, lines 19-48.

Regarding claims 25-26 and 28, Dahlen further teaches limitations of the claims in col.10, lines 38-48.

Regarding claims 46, 47, 48, 50, 51 and 52, the limitations of the claims are rejected with the same reasons set forth in claims 1, 16 and 29 above.

5. Claims 1-4, 6, 16-17, 19, 46, 47, 48, 50, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohuchi (US Pat. #: 5,805,671 as cited in the previous Office Action) in view of Helferich et al. (US. Pat. #: Re. 34,976).

Regarding claim 1, Ohuchi teaches a communication system comprising:

a first communication device (i.e., exclusive-use telephone 21 as shown in figure 1) for transmitting outgoing data including content identification data, transmitting party identification data, receiving party identification data, and date and time data (col.5, lines 13-22 and col.6, lines 10-35); and

a second communication device (i.e., MAIN UNIT (COTROL UNIT 1)) for receiving said outgoing data and for transmitting content data identified by said content identification data to a receiving party identified by said receiving party identification data at a date and time corresponding to said date and time data (col.6, line 36 through col.7, line 7).

It should be noticed that Dahlen further teaches a third *wireless* communication device (i.e., receiving equipment of the called party such as GSM mobile radio 100E as shown in figure

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1) for receiving and reproducing said content data transmitted from said second communication device (col.8, lines 3-35) and the text-to-speech conversion service (see col.10, line 60 through col.11, line 29). Dahlen, however, fails to clearly teach the features of storing the audio content data from the second communication device without pushing an off-hook button. However, Helferich teaches an analog/digital voice storage cellular telephone that records or stores voice content data such as voice messages while the user is away from the cellular telephone unit (*without pushing an off-hook button*) (see the Abstract) for immediately delivering messages to recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of storing the audio content data from the second communication device without pushing an off-hook button, as taught by Helferich, into view of Ohuchi in order to directly provide the messages to the recipient.

Regarding claim 2, Ohuchi further teaches limitations of the claim in col.4, lines 15-30.

Regarding claim 3, Ohuchi further teaches limitations of the claim in col.3, line 66 through col.4, line 12.

Regarding claim 4, Ohuchi further teaches limitations of the claim in col.6, lines 10-14.

Regarding claim 6, Ohuchi further teaches limitations of the claim in col.7, line 66 through col.8, line 18.

Regarding claims 16-17 and 19, the limitations of the claims are rejected with the same reasons set forth in rejection of claims 1-4 and 6 above.

Regarding claims 46, 47, 48, 50, 51 and 52, the limitations of the claims are rejected with the same reasons set forth in claims 1, 16 and 29 above.



6. Claims 7, 14, 20, 27, 35, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen (US Pat. #: 5,870,454) in view of Helferich et al. (US. Pat. #: Re. 34,976) as applied to claims 1 and 16 above, and further in view of Brown et al. (US. Pat. #: 6,751,299 also cited in the previous Office Action).

Regarding claims 7, 20, 27, 39, Dahlen and Helferich, in combination, teaches all subject matters as claimed above, except for another communication device for transmitting advertisement data and sponsor identification data identifying a sponsor of said advertisement data to said second communication device. However, Brown et al. ("Brown") teaches such features in col.11, lines 43-48; col.11, lines 64-67; col.13, lines 43-61 and col.18, lines 42-47 for purpose of providing personal as well as business messages to recipients.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of another communication device for transmitting advertisement data and sponsor identification data identifying a sponsor of said advertisement data to said second communication device, as taught by Brown, into view of Dahlen and Helferich in order to achieve a more capable and efficient greeting voice message system to meet the ever increasing needs of subscribers.

Regarding claim 14, Brown further teaches limitations of the claim in col.11, lines 64-67; col.12, lines 20-23 and col.14, lines 13-31.

Regarding claim 35, Brown further teaches limitations of the claim in col.13, lines 36-31.

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7. Claims 41, 43-45, 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen (US Pat. #: 5,870,454) in view of Brown et al. (US. Pat. #: 6,751,299) or Ohuchi (US Pat. #: 5,805,671), and further in view of Helferich et al. (US. Pat. #: Re. 34,976).

Regarding claim 41, Dahlen teaches a mobile phone (i.e., terminal 22 or GSM mobile radio terminal 100E as shown in figure 1), comprising:

receiving means for receiving greeting mail; and reproducing means for reproducing the received greeting mail (col.9, line 27 through col.10, line 48).

It should be noticed that Dahlen fails to teach the feature of receiving advertisement data along with the greeting data. However, Brown teaches such features in col.14, lines 28-29.

It should be further noticed that Dahlen and Brown, in combination, fails to clearly teach the feature of transmitting to and controlling for a server device reception-complete data when message and advertisement have been received. However, Ohuchi teaches such features in col.7, line 66 through col.8, line 18.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features as taught by Brown and Ohuchi systems, into view of Dahlen in order to achieve a more capable and efficient greeting voice message system to meet the ever increasing needs of subscribers.

It should be noticed that Dahlen further teaches a third *wireless* communication device (i.e., receiving equipment of the called party such as GSM mobile radio 100E as shown in figure 1) for receiving and reproducing said content data transmitted from said second communication device (col.8, lines 3-35) and the text-to-speech conversion service (see col.10, line 60 through col.11, line 29). Dahlen, Brown or Ohuchi, in combination, fails to clearly teach the features of

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storing the audio content data from the second communication device without pushing an off-hook button. However, Helferich teaches an analog/digital voice storage cellular telephone that records or stores voice content data such as voice messages while the user is away from the cellular telephone unit (*without pushing an off-hook button*) (see the Abstract) for immediately delivering messages to recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of storing the audio content data from the second communication device without pushing an off-hook button, as taught by Helferich, into view of Dahlen, Brown or Ohuchi in order to directly provide the messages to the recipient.

Regarding claims 42-45, Dahlen further teaches limitations of the claims in col.10, lines 38-48.

Regarding claims 49 and 53, the reasons for rejection of claims 49 and 53 are set forth the same in claim 41 above.

### ***Allowable Subject Matter***

8. Claims 8-10 and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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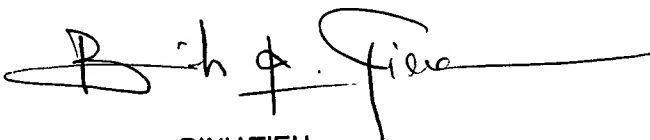
In order to expedite the prosecutions, the following references are presented to the Applicant(s) for review along with future amendment(s) in order to eliminate unnecessary future Office Action(s).

Khan (US. Pat. #: 6,529,592) and Logan et al. (US. Pat. #: 5,732,216). They are combined to teach all imitations of the above rejected claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

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BINH TIEU  
PRIMARY EXAMINER

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Date: August 30, 2006